



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Sunil Kumar Chandrupatla et al.
SERIAL NO.: 09/198,590 CONFIRMATION NO.: 2698
FILING DATE: November 23, 1998
TITLE: AGGREGATION OF USER USAGE DATA FOR ACCOUNTING
SYSTEMS IN DYNAMICALLY CONFIGURED NETWORKS
EXAMINER: Nguyen, Nga B. TELEPHONE: (571) 272-6796
ART UNIT: 3628 FAX: (571) 273-8300

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on the date printed below:

Date: October 5, 2006

Name: 

Karen A. Rogers

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**PETITION FOR RECONSIDERATION OF FINALITY OF OFFICE ACTION
UNDER 37 C.F.R. § 1.181 AND MPEP §§ 706.07(A) AND 2144.03(D)**

Dear Sir:

This paper is in further response to the Final Office Action dated May 5, 2006.
The finality of this Office Action is premature under M.P.E.P. §§ 706.07(A) and 2144.03(D) and thus the Applicants respectfully request under 37 C.F.R. § 1.181 that a new-non final Office Action be issued.

M.P.E.P § 706.07(A) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on

information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

M.P.E.P § 706.07(A). And M.P.E.P § 2144.03(D) states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. See MPEP § 706.07(a).

M.P.E.P § 2144.03(D) (emphasis added).

There are two completely new grounds for rejection in the Final Office Action dated May 5, 2006¹ ("Final Office Action") which were not presented in the previous Office Action² ("First Office Action"). First, in the First Office Action, Claims 1-13, 15, 16, 18, 23, and 36-49 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sawyer^{3,4}. The Examiner admitted that Sawyer does not disclose "accounting start-stop event data is obtained from two or more accounting servers via an information bus, wherein the information bus contains the accounting start-stop event data published by the two or more accounting servers; and network flow data is obtained from two or more routers," but did not provide a specific reference where such a limitation is found, instead arguing that these features are "well known in the art".⁵ In a Response to Office Action dated January 12, 2006 ("Response to Office Action"), the Applicants assumed that the Office Action intended to take official notice of facts under M.P.E.P. § 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-known" prior art Under M.P.E.P. § 2144.03.⁶ The Applicants traversed the assertion

¹ Office Action dated May 5, 2006.

² Office Action dated October 12, 2005.

³ U.S. Patent No. 5,828,737 to Sawyer.

⁴ Office Action dated October 12, 2005, ¶ 5.

⁵ Office Action dated October 12, 2005, ¶ 5, p. 3.

⁶ Response to Office Action dated January 12, 2006, p. 13.

and requested that a reference be cited in support of the position outlined in the Office Action.⁷ In the Final Office Action, the Examiner used newly added reference Saari⁸ to support his contention that certain features recited in the First Office Action were well-known in the art.⁹ This new ground of rejection could not possibly be necessitated by information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) as no such IDS has been filed. Nor could this new ground of rejection be necessitated by the Applicant's amendment of claims as the claims were not amended in the Response to Office Action. Therefore, the only question is whether the Examiner's addition of the new reference (Saari) results in a new issue or constitutes a new ground of rejection. The Applicants respectfully submit that Saari is not directly corresponding evidence to support the Examiner's prior knowledge finding because Saari does not disclose the features recited in the First Office Action that the Examiner contends were well-known in the art. To the extent that the Examiner contends Saari does disclose these features, the addition of the Saari reference constitutes a new ground of rejection – a rejection under 35 U.S.C. § 103 based on Sawyer in view of Saari. For this reason, the finality of the Office Action dated May 5, 2006 is improper.

Second, there is a brand new 35 U.S.C. § 103 rejection of Claims 2, 13, 16, 36, and 44. In the First Office Action, the Examiner contended that Sawyer disclosed the “publishing the accounting start-stop event data on an information bus” element of Claim 2.¹⁰ This element is also found in Claims 13, 16, 36, and 44. Importantly, the Examiner did not contend this element was well-known in the art in the First Office Action. In the Response to Office Action, the Applicants contended that Sawyer did not teach this element.¹¹ In the Final Office Action, the Examiner stated:

In response to applicant's argument that Sawyer fails to teach that the accounting star-stop event data is published, examiner submits that Saari also discloses the accounting start-stop event data is published by the two or more accounting servers (see figures 2-3 and column 5, lines 47-55, the charging information is transmitted to the external billing system 40). It is note that the term “publish” is defines as “to make data available so that it may by read by another person or

⁷ Response to Office Action dated January 12, 2006, p. 13.

⁸ U.S. Patent No. 6,338,046 to Saari.

⁹ Office Action dated May 5, 2006, ¶ 3, pp. 2-3.

¹⁰ Office Action dated October 12, 2005, ¶ 5, p. 4.

¹¹ Response to Office Action dated January 12, 2006, pp. 14-15.

computer program” (see “The New Penguin dictionary of Computing” by Dick Poutain, “publish”, submitted by the applicant). Thus, in Saari, the nodes 24a, 24b publish charging information to the external billing system 40, or the nodes 24a, 24b publish charging information to the external billing system 40).

In conclusion, for the reason set forth above, examiner decides to maintain the previous rejection and make the Office action FINAL.¹²

Thus, the Examiner relies on other teachings in Saari to show an element that the Examiner had previously contended was disclosed by Sawyer; the Examiner did not previously contend the element was common knowledge. And since the Examiner is relying on a teaching in Saari for a reason other than to support the prior common knowledge statement, a new ground of rejection has been introduced. Furthermore, as the claims were not amended in the Response to Office Action dated January 12, 2006, this new ground of rejection was not necessitated by the Applicant’s amendment of claims. For this additional reason, the finality of the Office Action dated May 5, 2006 is improper.

The goal of the rules regarding premature final office actions is to ensure that Applicants are provided with an opportunity to respond during pendency of the application to rejections raised by the Patent Office. Without such rules, Applicants could be denied the opportunity to be heard on one or more issues. In this case, the Applicants have duly paid the filing fees for the present application, and are entitled to a full and diligent search as well as an opportunity to respond to any rejections or objections raised by an office action. In this case, however, the Applicants have been what is commonly known as "sandbagged," where a rejection that could easily have been raised by the First Office Action, was instead held back and only made in a Final Office Action, thus denying the Applicants the opportunity to respond without paying to file a Request for Continued Examination. Such action is impermissible under MPEP §§ 706.07(A) and 2144.03(D) and thus it is respectfully requested that the finality of this Office Action be withdrawn and a new, non-final Office Action be issued.

If, in the opinion of the Examiner, a telephone interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

¹² Office Action dated May 5, 2006, ¶ 3, p. 3.

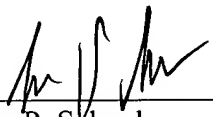
Reconsideration in view of the above remarks is respectfully requested.

It is believed that no fee is required for this petition. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

Dated: October 5, 2006



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